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09/582,714	10/03/2000	Arnaud Vilbert	5725.0622	8388

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1619

13

DATE MAILED: 12/05/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,714

Applicant(s)

VILBERT, ARNAUD

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-71 is/are pending in the application.
- 4a) Of the above claim(s) 32-38, 42, 46-57, 59, 70 and 71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-31, 39-41, 43-45, 58 and 60-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1. 6) ☐ Other: _____

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DETAILED ACTION

Claims 27-71 are pending. Claims 32-38, 42, 46-57, 59 and 70-71 are withdrawn from consideration, as they are directed toward non-elected subject matter. Claims 27-31, 39-41, 43-45, 58 and 60-69 were examined on their merits.

Election/Restrictions

Applicant's election with traverse of October 24, 2001 in Paper No. 12 is acknowledged. The traversal is on the ground(s) that the Examiner has failed to properly show that claims 27-71 lack unity of invention. This is not found persuasive because the polycondensates of the instant invention may be comprised of compound (1) and/or compound (2) and/or compound (3), or formula (I'), which comprises 5 variable regions, or formula (II'), which also comprises 5 variable regions, resulting in a massive number of possible chemical compounds with different chemical structures and properties, hence lacking the same or corresponding special technical features.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 27-71 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/385,412 and over claims 1-33 of copending Application No. 09385015. Although the conflicting claims are not identical, they are not patentably distinct from each other because all sets of claims are directed toward aerosol devices comprising polyurethane/polyurea condensates and film forming polymers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 31, 32, 36, 39, 41, 42, 46, 48, 51, 52 and 54-57, 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 31 is vague and indefinite, as it is not clear how this claim further limits claim 29, which already recites polycondensate (A) as in block form.

(ii) Claim 32 is vague and indefinite, as it is not clear how the blocks are obtained from (1) and/or (2) and/or (3). Does it mean that the blocks are made of the compounds of (1), (2) and/or (3), or does it mean something else?

(iii) The term "active" in claim 32 (line 3) is a relative term which renders the claim indefinite. The term "active" is not defined by the claim, the specification does not provide a

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standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

(iv) Claim 36 is vague and indefinite, as it is not clear how the polycondensate can be formed from silicones when it comprises polyurethanes and polyurea blocks. Do the silicones transform into polyurethane or polyurea blocks?

(v) The phrase "carbon-based" in claims 32 (line 2) and 39 (line 6) is vague and indefinite, as it is not clear what chemical compounds/substituents this phrase encompasses. Does it mean 1 carbon atom, does it mean 10, does it mean something else?

(vi) The phrase "divalent radical derived from isophorone" in claim 41 (line 3) is vague and indefinite, as it is not clear what chemical compounds are encompassed by this phrase, as it is not known what divalent radicals come forth from isophorone. The specification does not further define this phrase and one of ordinary skill in the art would not be apprised of the phrase.

(vii) The phrase "aromatic type" in claims 39 (lines 8-9) and 42 (lines 7-8) is vague and indefinite, as it is not disclosed what alkylene radicals aside from those which are aromatic, are encompassed by this phrase.

(viii) The term "lower" in claim 46 (lines 10 and 11) is a relative term which renders the claim indefinite. The term "lower" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Does it mean 1 carbon atom, does it mean 30, does it mean something else?

(ix) The phrase "units derived from sulphonic acid" in claim 46 (line 13) is vague and indefinite, as it is not clear what chemical compounds/substituents are encompassed by this phrase.

(x) The phrase "derived from" in claim 48 (lines 4-9) and 52 (line 2) and 54 (lines 4-10), 55 (line 1), 56 (line 1), 57, (lines 3-8) is vague and indefinite, as it is not clear what chemical compounds/polymers are encompassed by this phrase.

(xi) The phrase "phenylvinyl derivatives" in claim 51 (line 3) is vague and indefinite, as it is not clear what chemical compounds are encompassed by this phrase.

(xii) The phrase "functionalized and non-functionalized" in claim 59 (line 2) is vague and indefinite, as it is not clear what limitations this phrase places on polyurethanes.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27-31, 39-41, 43-45, 58 and 60-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mougin et al. (6,166,093), Mougin (5,643,581) or Mondet et al. (EP 751162) in view of Beitone et al. (5,653,963).

Mougin et al. ('093), Mougin et al. ('581) and Mondet et al. teach cosmetic/dermatological compositions of polyurethane and/or polyurea block polycondensation products containing silicone grafts, wherein formula I' of the instant invention is disclosed. The silicone grafts are disclosed as comprising a polysiloxane portion and a non-silicone organic

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chain portion. The compositions are further disclosed as comprising organic solvents and other additives, and are disclosed for use as hair care products in the form of aerosols. The polycondensates are disclosed as comprising 0.5 to 50% of the composition. Disclosed are methods of making and using the polycondensate composition. Droplet sizes of the composition are disclosed as ranging from 5 to 400 nanometers and as be regulated by varying the respective proportions of polycondensation product, organic solvent and water. The references fail to teach a device. See entire disclosures of references.

Beitone et al. teach aerosol systems for hair lacquer equipped with a dispensing valve and comprising a composition of water, organic solvent, and film forming resin. See abstract and Col. 5, line 1-Col. 6, line 35.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the compositions of Mougin, Mougin and Mondet in the aerosol system of Beitone et al. and obtain a dispenser device comprising a reservoir containing a hair composition because a) Mougin, Mougin and Mondet all teach aerosols and the definition of an aerosol is a substance, such as paint, a detergent, or an insecticide, packaged under pressure with a gaseous propellant for release as a spray of fine particles¹, hence the teaching of an aerosol composition inherently implies a composition within a dispenser; b) Mougin, Mougin and Mondet all teach hair care compositions comprising water, organic solvents and film forming agents in the form of aerosols and Beitone teaches aerosol systems comprising hair care compositions comprising water, organic solvents and film forming agents contained in a dispenser device.

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The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references. Therefore, the claims are properly rejected under 35 U.S.C. § 103.

Prior Art

The prior art made of record and not specifically relied upon in any rejections cited above is either 1) considered cumulative to the prior art that was cited in a rejection or is 2) considered pertinent to the applicant's disclosure and shows the state of the art in its field but is not determined by the Examiner to read upon the invention currently being prosecuted in this application.

Notes/Comments

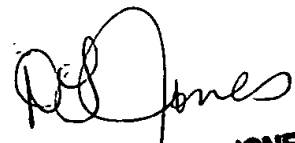
The Examiner respectfully suggests that the phrase "is" be deleted from claim 63, line 2.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.


DAMERON L. JONES
PRIMARY EXAMINER

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lqw

November 1, 2001